



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,395	08/13/2001	Vitaly Arkadievich Livshits	212607US0DIV	7391

20985 7590 04/29/2004

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
----------	--------------

1652

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,395

Applicant(s)

LIVSHITS ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 8-14 and 27 is/are allowed.
- 6) ☒ Claim(s) 15-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/396,357.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-12-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

The request filed on 9-17-03 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/927,395 is acceptable and a RCE has been established. An action on the RCE follows.

Claims 1-5 and 8-27 are now at issue and are present for examination.

Applicants' amendments and arguments filed on 9-17-03 have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Specification

The disclosure is objected to because of the following informalities: Applicants need to update the relationship of the instant application with the parent application. It is noted that the parent application has matured into a US patent. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15, 21 and claims 16-20 and 22-26 which depend therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15, 21 recites the phrase "under stringent conditions". A perusal of the specification provides a

Art Unit: 1652

definition which is very vague or incomplete. Contrary to applicant's argument, from the above definition for stringent conditions those skilled in the art cannot readily determine those conditions. Therefore the use of the above phrase renders the claim indefinite as used in the context of the above claim. In his previous Office action Examiner suggested applicants to amend the claim in such a way as to link the per cent homology language to the stringent conditions. However claims as amended now show no such link to the >70% homology limitation. Hence the above rejection is maintained.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for DNA with SEQ ID NO:1 or nucleotides 557 to 1171 of SEQ ID NO:1, encoding polypeptide with amino acid sequence of SEQ ID NO:2 which renders the cells in which the DNA is expressed, homoserine resistant or an isolated polynucleotide encoding a protein which comprises amino acid sequence including deletion, substitution, insertion or addition of one amino acid in the amino acid sequence, SEQ ID NO:2 and having an activity of rendering a bacterium homoserine resistant does not reasonably provide enablement for any DNA which hybridizes under stringent conditions to nucleotides 557-1171 of SEQ IDNO:1 and is at least 70% homologous to nucleotides 557 to 1171 of SEQ ID NO:1 and encodes a protein having an activity of rendering a bacterium homoserine resistant. The specification does not

Art Unit: 1652

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Factors to be considered in determining whether undue experimentation is required, are summarized in *In re Wands* (858 F.2d 731, 8 USPQ 2d 1400 (Fed. Cir. 1988)) as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claim(s).

Claims 15-26 are so broad as to encompass any DNA which is a variant, mutant or a recombinant of nucleotides 557-1171 of SEQ ID NO:1 with at least 70% identity thereto and encoding a protein which renders a bacterium homoserine resistant from any or all sources and vectors and host cells (*E.coli*) comprising such DNAs. The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of DNA sequences that are broadly encompassed by the claims.

Applicants propose to use the above polynucleotides for recombinant process of production of amino acids. Since the nucleotide sequence determines the type of protein and the ultimate function of the encoded protein and since the predictability of which changes in the nucleotide sequence can be tolerated and still obtain a protein having the desired activity, requires a knowledge of and guidance with regard to which amino acids can be altered and which cannot be altered and a detailed knowledge of the ways in which the encoded protein structure relates to its function, changing the nucleotide sequences as proposed by the applicants and/or addition of substantial amount of additional nucleotide sequence unrelated to the nucleic acid

Art Unit: 1652

sequence of SEQ ID NO:1 may not lead to desired function of the polynucleotides. This is because the changes suggested by the applicants will result in an enormous number of nucleotide sequences that may or may not encode the polypeptide which renders the cells resistant to homoserine. It would require undue experimentation of the skilled artisan to make and use the claimed polynucleotides as claimed. The specification is limited to teaching use of SEQ ID NO: 1 and nucleotides 557 to 1171 of SEQ ID NO:1 for encoding a protein that renders a bacterium homoserine resistant but provides no guidance with regard to the making of variant and mutant polynucleotides or with regard to other uses of such polynucleotides. In view of the great breadth of the claim, amount of experimentation required to make the claimed polynucleotides, the lack of guidance, working examples, and unpredictability of the art in predicting function from an encoded polypeptide primary structure (e.g., see Ngo et al. in *The Protein Folding Problem and Tertiary Structure Prediction*, 1994, Merz et al. (ed.), Birkhauser, Boston, MA, pp. 433 and 492-495, Ref: U, Form-892), the claimed invention would require undue experimentation. As such, the specification fails to teach one of ordinary skill how to use the full scope of the polynucleotides encompassed by this claim.

While recombinant and mutagenesis techniques are known, it is not routine in the art to screen for multiple substitutions or modifications of nucleotides, as encompassed by the instant claims, and the base changes within a nucleic acid's sequence can be made with a reasonable expectation of success in obtaining the desired activity/utility are limited and the result of such modifications is unpredictable. In addition, one skilled in the art would expect any tolerance to modification for a given DNA to diminish with each further and additional modification, e.g. multiple substitutions.

Art Unit: 1652

The specification does not support the broad scope of the claims which encompass all modifications and fragments of any DNA which is a variant/mutant or having 70% homology to nucleotides 557-1171 of SEQ ID NO:1 and encoding a protein which imparts homoserine resistance to a bacterium because the specification does not establish: (A) regions of the DNA sequence which may be modified without effecting the above mentioned activity/utility; (B) the general tolerance of homoserine resistance imparting DNA sequence to modification and extent of such tolerance; (C) a rational and predictable scheme for modifying any nucleotide sequence with an expectation of obtaining the desired biological function and utility; (D) a specific hybridization condition and (E) the specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful.

Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed invention in a manner reasonably correlated with the scope of the claims broadly including any or all DNA which are at least 70% homologous to and hybridizes to SEQ ID NO:1 or nucleotides 557-1171 of SEQ ID NO:1 under "stringent conditions" and encoding a protein which imparts homoserine resistance to a bacterium. The scope of the claims must bear a reasonable correlation with the scope of enablement (In re Fisher, 166 USPQ 19 24 (CCPA 1970)). Without sufficient guidance, determination of DNAs having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. See *In re Wands* 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988).

In response to the previous Office action applicants have amended claim 15 to overcome the above rejection and added new claims. However, rejections have been applied to new

Art Unit: 1652

claims as well. Applicants submit that with respect to claim 15, provided with nucleotide sequence in SEQ ID NO:1 and the tools necessary to hybridize one DNA to another DNA and determine whether it has necessary homology and activity is within the well-described knowledge available in the art and in support of that applicants submit specific pages taken from a laboratory manual. Applicants also argue that homology searches can be done using the BLAST and FASTA search engines.

In response to the issues raised by the Examiner Applicants compare the RhtB protein with lysE gene and argue that those skilled in the art know that as in LysE gene, even in the RhtB gene the transmembrane domains are highly conserved and would be able to perform PCR reactions to obtain such highly conserved domains and therefore would not require undue experimentation. Applicants argue that PCR is a well known method that is routinely followed by those skilled in the art. Examiner agrees with the applicants that PCR is a highly common technique practiced in the art. However, Examiner respectfully disagrees with the applicants' argument that using such PCR technique to amplify conserved domains, it would be possible for those skilled in the art to obtain a variant as well as claimed by the applicants without any guidance regarding the specific nucleotides that can be changed while maintaining the property of the polynucleotide to encode a polypeptide than can confer homoserine resistance to *E.coli* cells.

Next, applicants argue that the specification provides a detailed explanation of how the artisan may clone and vary sequences. Examiner respectfully disagrees. While some general explanations are provided detailed explanation as to which specific amino acid residues can be changed while retaining the functional properties of the polypeptide are not provided. Guidance

Art Unit: 1652

for determination of the activity of the encoded polypeptide is not what the Examiner is questioning. It is agreed that applicants provide the assay to test the encoded polypeptides. However, the specification fails to provide guidance to make the variant polynucleotides capable of encoding polypeptides with the claimed activity.

Applicants also allege that Examiner is confusing the quantity of experimentation with undue experimentation. Examiner assures the applicants, that such a confusion does not exist in the Examiner's mind and the rejection is not based on any such confusion. As argued in his previous arguments, Examiner reiterates that, while methods to make changes in a polynucleotide or polypeptide are well known to the skilled artisan, producing and using polynucleotides as claimed by applicants requires that one of ordinary skill in the art know or be provided with guidance as to where or which specific amino acid sequence(s) need to be changed while retaining the function of the polypeptide. Without such guidance one of ordinary skill would be reduced to the necessity of producing and testing all of the virtually infinite permutations and combinations of the amino acids in the sequence. This would clearly constitute undue experimentation. It is clear to the Examiner that while enablement is not precluded by the necessity for routine screening, if a large amount of screening is required, the specification must provide a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. Such guidance has not been provided in the instant specification. As stated above the specification does not establish: (A) regions or specific nucleotide bases of the DNA sequence which may be modified without effecting the above mentioned activity/utility; (B) the general tolerance of homoserine resistance imparting DNA sequence to modification and extent of such tolerance; (C) a rational and predictable scheme for

Art Unit: 1652

modifying any nucleotide sequence with an expectation of obtaining the desired biological function and utility; (D) specific high-stringency hybridization conditions and (E) the specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful. Therefore the above rejection is maintained for claims 15-26.

Examiner has withdrawn the provisional rejection of claims 1-5 and 8-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. application/Publication No.09/847,392/20020102670 A1 in view of cancellation of claim 1-5 in the referenced application.

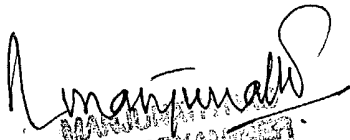
Conclusion

Claims 1-5, 8-14, 27 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The examiner can normally be reached on 6.30 a.m. to 3.00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Art Unit: 1652

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



MANJUNATH N. RAO
PATENT EXAMINER

Manjunath N. Rao
April 26, 2004